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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,621	08/17/2001	Yuichiro Deguchi	SONY-02800	6301

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O'BANION & RITCHEY LLP/ SONY ELECTRONICS, INC.
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SACRAMENTO, CA 95814

EXAMINER

HASHEM, LISA

ART UNIT	PAPER NUMBER
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2614

MAIL DATE	DELIVERY MODE
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10/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/932,621

Applicant(s)

DEGUCHI, YUICHIRO

Examiner

Lisa Hashem

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27, 30-32, 34-37 and 41-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27, 30-32, 34-37, 41-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see Amendment, filed 7-9-07, with respect to the rejection(s) of claim(s) 1-27,30-32,34-37 and 41-43 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-27,30-32,34-37 and 41-43 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. Appl. No. 2002/0145943 by Tree.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, Tree discloses a data marker integrated device communication system (Fig. 1), comprising:

Art Unit: 2614

a data marker integrated device configured to store a data mark in response to bookmarking of a broadcast clip (section 0025);

said data marker integrated device comprising a first device (Fig. 1, 100) which is configured for local, short range, wireless communication (section 0022; 0025);

a second device (i.e. personal computer) configured for establishing a first wireless communication connection with the first device to receive said data mark from said first device (section 0022); and

said second device configured for establishing a separate second wireless connection;

a server (i.e. server terminal) configured to connect over said second wireless connection to said second device for data communication through said second device with said first device (section 0038);

said second device configured for interfacing with a user in response to communication with said first device and/or said server (section 0038);

said server is configured for retrieving playlist data in response to receipt of said data mark from said first device (section 0038); and

said server is configured for communicating over a data network with a user terminal (i.e. PDA, mobile telephone) so that said user terminal can access said playlist data through a user account on said server when connected over said data network (section 0017; 0022; 0024; 0031).

Regarding claim 2, the system of claim 1, (section 0025).

Regarding claim 3, the system of claim 1, (section 0028; 0038).

Regarding claim 4, the system of claim 1, (section 0017; 0022; 0038).

Regarding claim 5, the system of claim 1, (section 0022; 0031).

Art Unit: 2614

Regarding claim 6, the system of claim 1, (section 0022; 0031).

Regarding claim 7, the system of claim 6, (section 0022; 0031).

Regarding claim 8, the system of claim 7, (section 0022; 0031).

Regarding claim 9, the system of claim 1, (section 0024; 0038).

Regarding claim 10, the system of claim 1, (section 0022; 0038).

Regarding claim 11, the system of claim 10, (section 0038).

Regarding claim 12, the system of claim 11, (section 0024; 0038).

Regarding claim 13, the system of claim 11, (section 0024; 0038).

Regarding claim 14, the system of claim 13, (section 0024; 0038; 0039).

Regarding claim 15, the system of claim 1, (section 0022).

Regarding claim 16, the system of claim 15, (section 0022).

Regarding claim 17, the system of claim 15, (section 0022).

Regarding claim 18, the system of claim 15, (section 0022).

Regarding claim 19, the system of claim 18, (section 0024; 0028).

Regarding claim 20, Tree discloses a method, comprising:

storing a data mark within a data marking device, as a first device (Fig. 1, 100), in response to

bookmarking of a broadcast clip (section 0025);

receiving, within a second device (i.e. personal computer), said stored data mark from said first device through a first wireless connection (section 0022; 0025);

establishing a second wireless connection from said second device to a server (i.e. server terminal) (section 0038);

Art Unit: 2614

transmitting said received data mark over said second wireless connection to a user account within a server (section 0038);
retrieving information corresponding to said marked data from a storage unit coupled to said server (section 0024; 0028; 0038);
establishing an internet connection between said server and a user terminal (i.e. PDA, mobile telephone); and
accessing information corresponding to said marked data within said user account on said server through said user terminal (section 0017; 0022; 0024; 0031).

Regarding claim 21, (section 0022; 0031).

Regarding claim 22, the method of claim 20, (section 0024; 0038).

Regarding claim 23, the method of claim 22, (section 0024; 0038).

Regarding claim 24, the method of claim 20, (section 0017)

Regarding claim 25, the method of claim 20, (section 0024; 0038).

Regarding claim 26, the method of claim 25, (section 0024; 0038).

Regarding claim 27, the method of claim 25, (section 0024; 0038; 0039).

Regarding claim 30, the method of claim 20, (section 0024; 0028).

Regarding claim 31, Tree discloses a method, comprising:

storing a data mark within a data marking device, as a first device (Fig. 1, 100), in response to bookmarking of a broadcast clip (section 0025);
transmitting said stored data mark from a first wireless connection of said first device through a Bluetooth protocol connection to a second device (i.e. mobile telephone) (section 0022; 0025; 0031);

Art Unit: 2614

receiving said transmitted data mark by said second device (section 0022; 0025; 0031);
said second device comprising a mobile device configured for establishing a Bluetooth protocol connection and a separate second communication connection having a longer range than said Bluetooth protocol connection (i.e. Internet) (section 0022; 0025; 0031; 0038);
transmitting said received data mark through a wireless connection which is separate from said Bluetooth protocol connection, to a server (section 0024; 0031; 0038);
retrieving information corresponding to said marked data by said server (i.e. server terminal) (section 0024; 0031; 0038);
establishing an internet connection between said server and a user terminal (i.e. PDA, personal computer); and accessing information corresponding to said marked data on said server through said user terminal (section 0017; 0022; 0024; 0031).

Regarding claim 32, the method of claim 31, (section 0024; 0038).

Regarding claim 34, the method of claim 31, (section 0017).

Regarding claim 35, the method of claim 31, (section 0024; 0038).

Regarding claim 36, the method of claim 35, (section 0024; 0038).

Regarding claim 37, the method of claim 31, (section 0024; 0038; 0039).

Regarding claim 41, (section 0024; 0028).

Regarding claim 42, Tree discloses a data marker integrated device communication system (Fig. 1), comprising:
means for storing a data mark within a data marking device, as a first device (Fig. 1, 100), in response to bookmarking of a broadcast clip (section 0025);

Art Unit: 2614

means for receiving stored data mark through a first wireless connection by a second device (i.e. personal computer) (section 0022; 0025; 0031);

means for establishing a second wireless connection from said second device to a server (i.e. server terminal) (section 0024; 0031; 0038);

wherein said first wireless connection is a local, short range, wireless protocol that differs from said second wireless connection (section 0022; 0025; 0031; 0038);

means for transmitting said received data mark using said second wireless connection to said server;

means of retrieving information corresponding to said marked data by said server (section 0024; 0031; 0038);

means of establishing an internet connection between said server and a user terminal (i.e. PDA, mobile telephone);

means of accessing information corresponding to said marked data on said server through said user terminal (section 0017; 0022; 0024; 0031).

Regarding claim 43, Tree discloses a data marker integrated device communication system (Fig. 1), comprising:

means for storing a data mark within a data marking device, as a first device (Fig. 1, 100), in response to bookmarking a broadcast clip (section 0025);

means for transmitting said stored data mark through a Bluetooth protocol connection which provides a first wireless connection to a second device (i.e. personal computer) (section 0022; 0025; 0031);

Art Unit: 2614

means for receiving said transmitted data mark within said second wireless device; means for transmitting said received data mark through a second wireless connection, which is separate from said first wireless connection, to a server;

means for retrieving information corresponding to said marked data by said server (section 0024; 0031; 0038);

means of establishing an internet connection between said server and a user terminal (i.e. PDA, mobile telephone); and means of accessing information corresponding to said marked data on said server through said user terminal (section 0017; 0022; 0024; 0031).

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

5. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

6. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-27, 30-32, 34-37, and 41-43 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U. S. Patent No.

7,127,454 and claims 1-26 of U.S. Patent No. 7,107,234. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claims 1-18 of the '454 patent and claims 1-26 of the '234 patent pertain to the same subject matter as the instant application including: '...a data marking device configured to store a data mark in response to bookmarking of a broadcast clip...', '...a second device to receive said data mark from said data marking device...', and '...a server for retrieving playlist data in response to receipt of said data mark from said data marking device...'.

8. Claims 1-27, 30-32, 34-37, and 41-43 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 7,190,971, claims 1-17 of U.S. Pat. No. 7,062,528, and claims 1-61 of U.S. Patent No. 6,578,047. Although the conflicting claims are not identical, they are not patentably distinct from each other because both patents pertain to the same subject matter as the instant application including: '...a device storing information providing a means by which content elements may be identified by an external means, such as a server...'.

It would have been obvious to one of ordinary skill in the art to modify the patents to provide a data marking device configured to store a data mark in response to bookmarking of a broadcasting clip or music file in order to store and remind a user of preferred content selected by the user.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 Form.

10. Any response to this action should be mailed to:

Art Unit: 2614

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communications intended for entry)

Or call:

(571) 272-2600 (for customer service assistance)

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lh
September 26, 2007

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

